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IN THE

Supreme Court of the United States

October Term, 1964

No. 960

PENNCO ENGINEERING COMPANY,

Petitioner

v.

ALLIED CHEMICAL CORPORATION,

Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner, plaintiff-appellant below, respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit entered in the above-entitled action on December 7, 1964.

OPINIONS BELOW

The opinion of the United States District Court for the Eastern District of Virginia, including its Findings of Fact and Conclusions of Law, is reported at 235 F.Supp. 625, and

is printed in Appendix A infra at Volume I, page 130a. The United States Court of Appeals for the Fourth Circuit affirmed per curiam; its decision is reported at 339 F.2d 260 and is printed in Appendix A, infra Volume IV, page 6.

JURISDICTION

The Judgment of the Court of Appeals was entered on December 7, 1964.* The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

QUESTIONS PRESENTED

The questions presented are:

1. Can drawings of a prior patent be interpreted according to the opinion of a trial court to show something not disclosed in the patent specification and this interpretation then relied upon as prior art against a later patent covering a meritorious invention?

2. Can the statutory presumption of validity, which is accorded a patent under 35 U.S.C. §282, be weakened or destroyed by such an interpretation of the drawings of a prior patent which the Patent Office "failed" to cite or consider?

3. Did the Courts below apply the proper legal standards in holding that the Nusbaum patent in suit No. 2,956,708 is invalid for lack of invention?

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* See Record Vol. IV, pp. 5, 8.

STATUTE INVOLVED

The District Court referred to §282 and §103 of Title 35 U.S. Code, and those sections are involved here in connection with questions 2 and 3 respectively. These sections read as follows:

§ 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having

prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. July 19, 1952, c. 950, § 1, 66 Stat. 812.

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798.

STATEMENT OF THE CASE

Petitioner brought this suit against Respondent for infringement of U. S. Letters Patent No. 2,956,705 issued on October 18, 1960, to Petitioner as assignee of the inventor, Simon Richard Nusbaum (Appellant's Appendix Vol. II, p. 144a).

The subject matter of invention of the patent in suit has to do with a container for holding and dispensing a refrigerant medium such as Freon which is charged into the container under pressure so that some exists therein in the liquid state and some in the gaseous state.

Such containers are used for charging the refrigerant in measured amounts, and selectively in either gaseous or liquid form, into a refrigerating or air conditioning system or the like. For these purposes the container, usually cylin-

drical in shape, is provided at one end with an outlet passage controlled by a manual shut-off valve. When it is desired to charge the refrigerant in gaseous form, the cylinder is stood upright on its opposite end so that the body of liquid therein occupies the lower end so that the gaseous head space above the liquid is in communication with the outlet passage. On the other hand, in order to charge the refrigerant in the liquid state, the cylinder must be inverted and maintained in that position so that when the body of liquid fills the lower end, it is in communication with the outlet passage.

In both cases, the valve must be opened and closed by hand at the right moments to charge the desired measured quantity of refrigerant, the container being maintained in either one or the other position throughout charging. For a number of reasons, however, it is difficult for the serviceman to hold the container in the inverted position and at the same time to operate the valve manually at the right moments. To eliminate these difficulties, Nusbaum surrounded the valve and outlet passage with a collar of sufficient length to allow the cylinder to stand on its end in inverted position without allowing the valve to touch the supporting surface. The collar extended beyond the end of the valve a substantial amount so that the valve handle was spaced from the supporting surface enough to be readily grasped by the serviceman and easily and quickly manipulated. To permit such manipulation of the valve, in either position of the cylinder, the collar was provided with a side access opening.

The District Court held the patent invalid as lacking invention, but in reaching this conclusion it evidently relied in part on its own unjustified interpretation of the drawings of a prior patent not cited by the Patent Office (Underhill No. 2,234,458) to "weaken" the statutory presumption of validity which otherwise would have supported the patent under 35 U.S.C. §282.

REASONS FOR GRANTING THE WRIT

1. THE DRAWINGS OF A PATENT CANNOT BE INTERPRETED TO DISCLOSE SOMETHING TOTALLY ABSENT FROM THE SPECIFICATION, ESPECIALLY WHERE THERE IS NO CLEAR SHOWING EVEN IN THE DRAWINGS THEMSELVES. IN THIS RESPECT THE RELIANCE OF THE COURTS BELOW ON THE UNDERHILL PATENT WAS CONTRARY TO THE LAW ESTABLISHED BY THE DECISIONS OF THIS COURT.

The Underhill patent * shows a cylindrical container having an outlet passage and valve at one end which are surrounded by a collar. It also shows the inversion of the cylinder to rest on this collar when it is desired to *empty* the container, the discharge valve of course being left open until all the contents have drained out.

There is *nothing in the patent* which *describes any operation of the valve in this inverted position of the cylinder*, as would be necessary to charge a measured quantity less than the entire contents of the cylinder. The most that Respondent's witness would say in this respect was that "it *appears* that the valve is readily *accessible*." (Appellant's Appendix, Vol. I, page 58a).

In spite of lack of disclosure in the specification and ambiguity of the drawings, the District Court (Finding of Fact No. 26; Appellant's Appendix, Vol I, p. 138a) took the position that the drawings of the container in the upside-down position "showed plenty of room to operate the handwheel while the container is in use."

One of the first authoritative pronouncements of this Court with regard to the significance of the drawings of a patent, as differentiated from express description, was in the leading case of *Topliff v. Topliff*, 145 U.S. 156, 12 S.Ct. 825, 36 L.Ed. 658. At page 161 of 145 U.S., this Court said

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* Appellant's Appendix, Vol. II, p. 296a.

with reference to an asserted interpretation of patent drawings that:

> "It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

The principle of the above quotation has been consistently followed ever since *Topliff*. In 1922, the Sixth Circuit Court of Appeals summarized the law in *Fulton Co. v. Bishop & Babcock Co.*, 284 F. 774, 777, as follows:

> "We recognize that prior patents are part of the prior art only by what they disclose on their face (Naylor v. Alsop Process Co. [C. C. A. 8] 168 Fed. 911, 920, 94 C. C. A. 315; Munising Co. v. American Sulphite Pulp Co. [C. C. A. 6] 228 Fed. 700, 703, 143 C. C. A. 222); that prior accidental production of the same thing, where the character and function were not recognized until the invention of the later patent, does not effect anticipation (Tilghman v. Proctor, 102 U. S. 707, 711, 26 L.Ed. 279; Topliff v. Topliff, 145 U. S. 156, 161, 12 Sup. Ct. 825, 36 L.Ed. 658; Canda v. Mich. Iron Co. (C. C. A. 6) 124 Fed. 486, 492, 61 C. C. A. 194; Munising Co. v. American Co., supra, 228 Fed. at page 703, 143 C. C. A. 222); and that anticipation is not disclosed by a drawing which only incidentally shows a similar arrangement of parts, where such arrangement is not essential to the first invention, and was not itself adopted and used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second inventor (Gray Telephone Co. v. Baird Co. [C. C. A. 7] 174 Fed. 417, 421, 98 C. C. A. 353; Munising Co. v. American

Co., supra, 228 Fed. at pages 703, 704, 143 C. C. A. 222)*

This Court had occasion to consider this point again in *Permutit Co. v. Graver Corp.*, 284 U.S. 52, where it said at page 60:

> "Moreover, while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim, they are of *no avail* where there is *an entire absence of description of the alleged invention or a failure to claim it.* McCarty v. Lehigh Valley R. Co., 160 U. S. 110, 116; Tinker v. Wilber Eureka Mower & Reaper Mfg. Co., 1 Fed. 138, 139; Gunn v. Savage, 30 Fed. 366, 369; Windle v. Parks & Woolson Machine Co., 134 Fed. 381, 384-5. The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. Merrill v. Yeomans, 94 U. S. 568, 573; Seymour v. Osborne, 11 Wall. 516, 541. The free bed was neither described in the specification nor claimed in either Claim 1 or Claim 5. Compare Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278; Alexander Milburn Co. v. Davis-Bournonville Co., 270 U.S. 390, 401." (Emphasis supplied.)

The consistent lack of authority illustrated by the above cases shows clearly that *in the total absence of any*

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* Later cases to the same effect include *Des Rosier v. Ford Motor Co.*, 143 F.2d 907, 912 (C.C.A. 1); *Trussell Mfg. Co. v. Wilson-Jones Co.*, 50 F.2d 1027, 1029 (C.C.A. 2); *Fo d Machinery Corp. v. Pacific Can Co.*, 66 F. Supp. 109, 112 (D.C.N.D. Cal.); *Goodrose Co., Inc. v. Charles Hvass and Co.*, 70 F.2d 625, 627 (C.C.A. 2).

description of "plenty of room to operate the handwheel" while the container is inverted, the lower court could not properly interpolate this feature into the Underhill patent merely on the basis of an inspection of the drawings, especially where there was no clear indication of this feature in the drawings themselves. In this respect, therefore, the findings, conclusions, and decision of the District Court and the affirmance per curiam by the Court of Appeals were in conflict with established law, more particularly with the above decisions of this Court.

2. THE STATUTORY PRESUMPTION OF VALIDITY IS NOT WEAKENED IN THIS CASE BY THE FACT THAT THE UNDERHILL PATENT WAS NOT CITED BY THE PATENT OFFICE. IN DECIDING THE CASE ON THIS PREMISE, THE COURTS BELOW APPLIED ERRONEOUS LEGAL PRINCIPLES.

Under §282 of Title 35, U.S. Code, the patent in suit is presumptively valid:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

The quoted §282 appeared in the patent laws for the first time in the codification of the patent laws in the Patent Act of 1952. However, this codification merely set forth in statutory form that which had been established law for many years. For example, the decision of this court in *Diamond Rubber Co. v. Consolidated Tire Company*, 220 U.S. 428 (1931) stated at page 434:

> "It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent."

The presumption is undoubtedly salutary as to prior art considered by the Patent Office before a patent is granted. For obvious reasons, however, it loses force as to a non-cited reference which is *more pertinent* than the references actually cited by the Patent Office Examiner; here the fact of greater pertinence of a non-cited reference gives rise to a presumption that the Examiner must have overlooked it. This was the situation in *Triumph Hosiery Mills, Inc., v. Alamance Industries, Inc.*, 299 F.2d 793 (C.A.4) on which the District Court relied in the present case in holding that the presumption was weakened in the present case by "failure" to cite the Underhill patent (Conclusion of Law No. 2, Appellant's Appendix, Vol. I, page 139a). The fact which the District Court overlooked in the present case is that the Underhill patent is no better reference than, if as pertinent as, Belgian Patent No. 514,045 (Appellant's Appendix, Vol. II, p. 299a) that the Patent Office did cite. Therefore the *Triumph* case does not apply.

There was no reason for the Examiner to have cited two patents where one would be just as effective, and therefore no presumption arises from alleged "failure" to cite the second patent. On the contrary, the presumption is that the Examiner, in the proper conduct of his job, did consider the Underhill patent but did not cite it because it was merely cumulative. The record shows that the Examiner did make a search in the class and subclass in which the Underhill Patent was classified.*

The only thing which the Patent Office "failed" to consider was the unjustified interpretation which the District Court placed upon the drawings of the Underhill patent. The Examiner, skilled in the daily application of rules of patent interpretation, undoubtedly took the Underhill patent at face value, as he should have done; did not read into it something that was not there, as did the District Court in the present case; and therefore did not cite this patent

* See Appellant's Appendix, Vol. I, pp 109a-111a; Vol. II, pp 290a and 295a.

but instead relied on the equivalent disclosure of Belgian Patent No. 514,045.

Under these circumstances, it is plain that the Nusbaum patent in suit is entitled to the benefit of the presumption of validity established by §282 quoted above. Under the circumstances of the present case, this presumption is not weakened but instead is strengthened for the reasons stated in *Power Curbers, Inc. v. E. D. Etnyer and Co.*, 298 F. 2d 484 (C.A.4), at page 493:

> "The fact that the defendants were unable to come up with any prior art more pertinent than the McIntyre patent strengthens the presumption of the validity of the patent in suit. As was said in Reynolds v. Whitin Mach. Works, 167 F.2d 78, 84 (4th Cir.), certiorari denied, 334 U.S. 844, 68 S.Ct. 1513, 92 L.Ed. 1768 (1948), '* * * patents for useful inventions ought not be invalidated and held for naught because of such excursions into the boneyard of failures and abandoned experiments.' In Chesapeake & O. Ry. Co. v. Kaltenbach, 95 F.2d 801, 804 (4th Cir. 1938), this court held: '* * * [T]he presumption of validity is strengthened where, as here, the principal references urged against the patent have been considered by the Patent Office.' See also Manville Boiler Co., Inc. v. Columbia Boiler Co. of Pottstown, Inc., 269 F.2d 600, 603 (4th Cir.), certiorari denied, 361 U.S. 901, 80 S.Ct. 208, 4 L.Ed. 2d 156 (1959); Gulf Smokeless Coal Co. v. Sutton, Steele & Steele, 35 F.2d 433, 437 (4th Cir. 1929), certiorari denied, 280 U.S. 609, 50 S.Ct. 158, 74 L.Ed. 652 (1930)."

3. THE LOWER COURTS APPLIED ERRONEOUS LEGAL STANDARDS IN DECIDING THAT THE PATENT IN SUIT WAS INVALID FOR LACK OF INVENTION.

The preceding sections of this petition show that the lower courts, particularly the District Court, relied on a legally fallacious interpretation of the Underhill patent to discount the statutory presumption of validity. The District Court then compounded the fallacy by holding (Conclusion of Law No. 5; Appellant's Appendix, Vol. I, p. 140a) that because lack of invention was "not doubtful", commercial success did not count either.

From these faulty premises, the District Court further proceeded to hold the patent in suit invalid in its entirety on the grounds stated in its Conclusions of Law Nos. 4(a) and 4(b). But *The Great Atlantic and Pacific Tea Co. v. Super Market Equipment Corp.*, 340 U.S. 147, on which these conclusions were based, dealt expressly with "combination patent claims", and approved an "exacting" standard of invention only with reference to "a combination [is] made up entirely of old elements". The present case does not involve such "combination patent claims".

If *A and P* applies to the present case, it is because §103 not only adopts the "exacting" standard of that case but also extends it to patent cases in general instead of to "combination patent claims" only.

On the other hand, an impressive number of cases since the Patent Act of 1952 have held that §103 liberalized the standard of invention. A leading case in this category is *Lyon v. Bausch and Lamb Optical Co.*, 224 F.2d 530 (1955), in which the late Judge Learned Hand adopted the construction of this section, and his decision was subsequently followed in a number of other circuits.[1] Among them

[1] See *R. M. Palmer Co. v. Luden's*, 236 F.2d 496 (3rd Cir); *Plax Corp. v. Precision Extruders, Inc.*, 239 F.2d 792 (3rd Cir); *Fisch v. Goul*, 246 F.2d 5 (3rd Cir.); *Brown v. Brock*, 240 F.2d 723 (4th Cir); *Otto v. Koppers Co.*, 246 F.2d 789 (4th Cir); *L-O-F Glass Fibers Co. v. Watson*, 228 F.2d 40 (C.A.D.C.).

was the Fourth Circuit which, following *Brown v. Brock* and *Otto v. Koppers* (see footnote 1), continued to follow the *Lyon* case and Judge Hand's "sensitive observations" (Palmer v. Ludens, footnoted) and the liberal standard of patentability.[2]

One of the most recent decisions in the Fourth Circuit on the point, *Berry Bros. Corporation v. Sigmon*, 317 F.2d 700 (1963), adopted the same view, after once more discussing thoroughly the divergent views of the various courts. With regard to the present case, *Berry v. Sigmon* is of particular interest because of its statement (p. 705):—

> It may well be that neither the statutory presumption of validity alone nor the evidence of commercial success alone would overcome the doubts raised as to this patent's validity; but *taking the presumption and the evidence of commercial success together*, we are led to accept the conclusion of the District Judge. (Emphasis supplied)

If neither of these considerations was available to the Court of Appeals in the present case, it was at least in part because of the District Court's legally unjustifiable interpretation of the Underhill patent.

The cases just discussed do not turn on whether the modification of the prior art, required to adapt it to Nusbaum's purposes, was "slight" (see Conclusion of Law No. 4(a)) or large. It is not quantum of change that counts, but instead quality or character of change and particularly the extent to which it is "obvious" to one having ordinary skill in the art. This test of invention stated in §103 merely codified existing law established by many years of precedent in this Court and in the lower courts. Among precedent authorities which clearly negative the quantum concept is

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[2] *Manville Boiler Co. v. Columbia Boiler Co. of Pottstown*, 269 F.2d 600; *Entron of Maryland, Inc. v. Jerrold Electronics Corp.*, 295 F.2d 670; *Power Curbers, Inc. v. E. D. Etnyer and Co.*, 298 F.2d 484, 493.

Hobbs v. Beach, 180 U.S. 383, in which this Court pointed out that patentable invention could reside in the recognition that a thing could be adapted to a different use, even though the amount of change in the form of mechanical alterations was very small. It said at pp. 392 and 393:—

> We agree with the courts below that it did involve invention *to see that a machine* of the Dennis and York type *was adaptable to the work of the Beach device*, and, second, to make such changes as were necessary to adapt that device to its new function. With all the anticipating devices before us, it is apparent that the mere *change* in the shape of the dies *was a minor part* of the work involved in so changing the Dennis and York machine as to make it perform a wholly different function, *the invention consisting rather in the idea that such change could be made*, than in making the necessary mechanical alterations. (Emphasis supplied)

In the present case, the inventor Nusbaum described the type of refrigerant charging cylinder that was in use for years prior to his invention, although its use was accompanied by substantial difficulties.* Also "propane pots" of the types introduced in evidence in this case and referred to by the District Court in Conclusion of Law No. 4(b) had been known for years prior to Nusbaum's invention. But it was not until 1958 that Nusbaum conceived the invention of the patent in suit, a substantial improvement in the art as shown by its prompt adoption and use, i.e., its commercial success. Meanwhile respondent, a long-time user of propane pots, never thought of adapting them to Nusbaum's purpose. Instead respondent respected Nusbaum's patent for several years while making various unsuccessful efforts to avoid it by the use of non-infringing alternatives and until respondent was finally obliged to pay Nusbaum's invention the tribute of imitation.

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* Appellant's Appendix, Vol. I, pp. 10a-13a.

Under such circumstances, it cannot be said that Nusbaum's invention was "obvious" to persons skilled in the art. All of the record points in the opposite direction.

CONCLUSION

The foregoing considerations all point to the urgent need for an authoritative pronouncement by the Supreme Court as to the meaning and interpretation to be given to §103 and the standard of invention thereby defined for the first time in statutory terms.

Since the 1952 Patent Act, a wide variety of different applications of §103 have been made by different courts, with a resultant state of confusion as to the meaning of the section. It is important for the reconciliation of the conflicting interpretations of this section, and in the interest of uniformity of application of the section by different courts, that the Supreme Court express its views for the guidance of the lower courts in this important branch of federal law. Only in this way will it be possible to achieve the stabilization desired and intended by Congress in enacting §103.

For the above reasons, this Petition should be granted.

Respectfully submitted,

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APPENDIX TO

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Opinion

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
RICHMOND DIVISION

Civ. A. No. 3474.

PENNCO ENGINEERING COMPANY

v.

ALLIED CHEMICAL CORPORATION

April 10, 1964.

* * * * * * * * * * *

BUTZNER, District Judge.

This action concerns plaintiff's Nusbaum United States Patent 2,956,708, entitled "Dispensing Containers for Refrigerants". The issues framed by the pleadings are di-

rected to the validity of the patent in suit and its alleged infringement by defendant in this District and elsewhere. The answer includes a counterclaim for a declaratory judgment that the patent is invalid and not infringed. Neither jurisdiction nor venue is disputed.

Findings of Fact

1. Plaintiff, Pennco Engineering Company (hereinafter referred to as "Pennco"), is a Pennsylvania corporation, having its principal office and place of business at Philadelphia, Pennsylvania. Simon Richard Nusbaum, president of Pennco, assigned the patent to Pennco. Assignment and ownership of the patent are not disputed. Defendant, Allied Chemical Corporation (hereinafter referred to as "Allied"), is a New York corporation, having its principal office and place of business in New York and a regular and established place of business at Hopewell, Virginia, in this District.

2. The suit relates to containers for dispensing refrigerants used in the cooling systems of refrigerators and air conditioning equipment. Air conditioning is a rapidly growing industry, which has greatly increased the use of refrigerants in recent times. The principal refrigerants now in use commercially are chemicals known as fluorinated hydrocarbons. Until late 1949, du Pont had a monopoly on fluorinated hydrocarbon refrigerants, which it sells under its trademark "Freon". Thereafter, several other companies became manufacturers of fluorinated hydrocarbon refrigerants. One of these is Allied, which makes and markets refrigerants under its trademark "Genetron". Pennco does not manufacture refrigerants. It packages in its containers and distributes refrigerants purchased from du Pont.

3. Refrigerants are dispensed in metal containers under pressure sufficient to keep much of the refrigerant in liquid form. The containers are closed metal cylinders. A dis-

pensing valve at one end is provided with an outlet for connection to a delivery hose or pipe leading to the system to be serviced. When a container is positioned so that gravity keeps liquid adjacent to the dispensing valve, liquid is discharged. When gas is adjacent to the dispensing valve, gas is discharged. Sometimes gas discharge is wanted and sometimes liquid discharge is desired. So, the practice is to place refrigerant containers in a position to discharge the contents in the proper form. It is inconvenient to hold or prop the containers in the inverted position which is required to dispense liquid. Pennco's container was designed to eliminate this inconvenience.

4. Neither Pennco nor Allied manufactures dispensing containers for refrigerants. The containers are purchased from companies such as Pressed Steel Tank Company which manufacture containers for holding and dispensing various gases under pressure for different uses.

5. The patent in suit issued October 18, 1960, on an application filed October 27, 1958. It relates to details of construction of metal containers useful for holding refrigerant under pressure and discharging it as a liquid or gas at the user's option. The Nusbaum Patent No. 2,956,708, discloses and claims dispensing containers for pressurized refrigerants for selectively dispensing such refrigerants in liquid or gaseous form. Manual operating access is available to the valve from the side when the valve is disposed downwardly for liquid refrigerant dispensing and the container is supported on a collar or end extension of the cylinder.

6. The container illustrated and described in the patent is a metal cylinder closed at both ends, with a dispensing valve located centrally on the top end. The dispensing valve illustrated and described in the patent has a lateral outlet for connecting it to a delivery hose or pipe to the equipment to be serviced, and a hand wheel for operating the valve manually.

7. A collar of lesser diameter than the cylinder is welded or "secured in any desired manner" to the top end of the cylinder and surrounds the discharge valve, except for an opening at one side. This opening is described as large enough and the collar high enough for an operator's hand to reach inside the collar to turn the valve handle to open and close the valve when the container is inverted and standing on the collar. A slot in the collar on the side opposite the opening serves as a handle for carrying the container. The top collar construction is described as being useful as a stand for the container when inverted, for protecting the valve from accidental knocks and for providing a carrying handle.

8. The bottom of the container described in the patent has a collar or "foot ring" on which the container stands in the upright position when gas delivery of its contents is wanted. The bottom collar serves also to protect from accidental damage a fuse plug in the bottom of the container. The bottom collar is larger in diameter than the top collar and has relative dimensions permitting the containers to be stacked with the bottom of each upper container resting on the top collar of the container below it, without interfering with the fuse plug in the bottom of the upper container.

9. The validity of patent is not based upon the following features of the refrigerant container (all of which were known to the industry):

The use of a container to dispense refrigerant in either liquid or gaseous form;

The use of a container in the upright or inverted position;

The metal cylinder or its various sizes;

The valve;

The hand wheel for operating the valve;

The collar on the top of the container which served to protect the valve;

The handhold in the collar for carrying the container;

The fuse plug;

The foot ring for protection of the fuse plug and for stacking.

10. The principal inventive concept claimed by the plaintiff is the relationship of collar height to valve height which permits manual access to the valve for dispensing liquid refrigerant when the container is inverted, the valve is down and the collar supports the container. This was achieved by lengthening the collar. A related concept is access through the handhold for the connectors.

11. The patent has five claims. Principal reliance is placed upon claims 1 and 5.

12. Claim 1, separated into parts and with letters added for convenience of discussion, reads as follows:

"1(a) In a dispensing container for pressurized dispensing refrigerant in liquid form,

"(b) a fluid tight container having opposite ends,

"(c) at least one of said ends having a longitudinally axially disposed extension therefrom of lesser diameter than the container for supporting said container with said one end downwardly disposed for liquid refrigerant dispensing,

"(d) said extension having a side access opening therein,

"(e) and a dispensing valve disposed within said extension and mounted on said one of said ends,

"(f) said dispensing valve having a discharge connection extending sidewise with respect to the longitudinal axis of the extension and towards said access opening,

"(g) said valve having an operating handle spaced inwardly from the outer marginal edge of the extension.

"(h) said extension being of a length with respect to the length of said valve to permit manual access to said valve handle through said access opening with said container supported by said extension and with said handle downwardly disposed."

13. Claim 5, separated into parts and with letters added for convenience of discussion, reads as follows:

"5(a) In a dispensing container for selectively dispensing pressurized refrigerant in liquid or gaseous form,

"(b) a fluid tight container having an interior liquid containing space and having exteriorly disposed thereon and secured to each of its opposite ends and extending therefrom a longitudinally axially disposed supporting collar,

"(c) each of said collars having a supporting end face for supporting said container with a selected one of said ends downwardly disposed,

"(d) a dispensing valve communicating with said space and an operating member therefor mounted on one of said ends,

"(e) said dispensing valve having a discharge outlet for the connection of delivery piping,

"(f) one of said collars supporting said container for liquid discharge from said space and the other of said collars supporting said container for gas discharge from said space."

14. Nusbaum's claim 2 differs from claim 1 in that (1) it specifies "an operating *portion*" for the valve whereas claim 1 specifies an "operating *handle*" for the valve, (2) it specifies "manual access to said valve *portion*" whereas claim 1 specifies "manual access to said valve

handle," and (3) with respect to the collar it specifies "a longitudinally axially disposed collar" whereas claim 1 specifies "a longitudinally axially disposed extension therefrom of *lesser diameter* than the container". In all other respects, claims 1 and 2 are the same.

15. Claim 3 of the patent in suit differs from claims 1 and 2 and is like claim 5 in being directed to containers for dispensing refrigerant in either gas or liquid form. Also, claim 3 refers to both the top collar and bottom collar as being of "*of different diameters*" from the cylinder. Also, claim 3 specifies that the side access opening in the collar extends from the end attached to the container to "the outer marginal edge" of the collar.

16. Claim 4 of the patent in suit differs from claim 3 by specifying that the top and bottom collars are not only of different diameters but also of lesser diameter than the container.

17. Defendant relies upon the following patents and publications anticipating the invention of the patent in suit:

(a) Belgian Patent No. 514,045, dated September 30, 1952, to Industrie Werke Karlsruhe, for dispensing purpose, cited by the Patent Office.

(b) Butane Propane News Catalog pages in 1953, 1954, 1955 and 1957 editions, not cited by the Patent Office.

(c) L. Underhill, U. S. Patent No. 2,234,458, dated March 11, 1941, not cited by the Patent Office.

18. Defendant also relies upon a propane pot of Green's Fuel of Florida to show prior public use.

19. Propane is a combustible hydrocarbon. It is dispensed from metal containers which are often called "propane pots". Containers for refrigerants and containers for propane bear many resemblances. Both are marked with the same Interstate Commerce Commission

specification numbers. They may be similar in size and shape. Either may have a fuse plug or this safety device may be incorporated in the valve. Collars and footrings are common to both. Many companies manufacture both. The art of making refrigerant containers is analogous to the art of making propane pots.

20. The chief difference between refrigerant containers and propane pots is the use to which each is put. They are not used interchangeably. The valves differ and consequently the valve spuds are of different diameter. Propane is dispensed only when the pot is in an upright position. Since a propane pot is not used in an inverted position for dispensing liquid, the relationship of the height of the valve to the height of the collar for providing manual access is not critical. The collar of a propane pot need be only high enough to protect the valve.

21. The 1952 Belgian patent entitled "Gas Cylinder, Preferably for Storage of Propane" was the most pertinent prior art cited by the Patent Office examiner. It illustrates and describes several forms of protective collars welded to the valve end of the cylinder to protect the valve and allow access to operate it. The Belgian patent, like the Nusbaum patent, describes the collar as being of "lesser diameter" than the cylinder, allowing it to fit inside the bottom collar or foot ring of another container for stacking purposes. It describes the collar construction as useful for protecting the valve and for carrying the container. The valve is shown as having an outlet connection and a handle for operating the valve by hand. The Belgian patent states that the top edge of its welded collar extends beyond the valve. The Belgian patent points out that the top collar extension, permitting the operation of the valve in inverted position, is useful because it makes possible rapid filling of the cylinders without requiring a special frame to support the cylinder.

22. The pages of the Butane-Propane News Catalog relied upon by defendant show propane pots, some with and some without valves. The illustrations and descriptions in the BPN catalogs were published prior to the time when Nusbaum first developed his container and more than a year prior to the filing of his patent application. They established that all structural details of the container of the Nusbaum patent were found in prior propane pots. These include collars of sufficient height to provide ample hand access to the valves. They of course do not illustrate propane pots in an inverted position for dispensing contents.

23. The Patent Office examiner in considering the Nusbaum Patent application did not cite any pages of the BPN catalog.

24. The 1941 Underhill patent, No. 2,234,458, relates to pressure containers and refers specifically, at page 1, column 1, lines 9-13, to containers for "Freon", the refrigerant to which the patent in suit also refers. The Underhill patent illustrates and describes a container with a valve centrally located on top, and used selectively in the right side up or in the upside down position. In the upside down position, the container is supported on a collar attachment. The hand wheel dispensing valve of the Underhill container, like the hand wheel dispensing valve of defendant's containers, has the built-in safety device, eliminating the need for a fuse plug in the body of the container.

25. Underhill's patent explains that his collar device replaces the old protective cap for the standard dispensing valve and provides "an attachment base for standing the container with the valve inverted." The patent specification points out that the device "permits the valve to be used without removing the device" and protects the valve "while in use". Underhill's protective collar attachment is described as one which "completely surrounds and

encloses the valve which is provided with the usual safety device and threaded outlet" and in many instances with a hand wheel. At page 1, column 2, lines 44-51 Underhill states also that his collar attachment provides "in combination, a valve cap or protective casing, a stand or base, handle means for transporting the container."

26. Underhill refers to the difficulties with earlier containers, and the advantages of his collar attachment, pointing out "Also, in empting the (earlier) container, if it contains liquid it is necessary to tip the container as obviously it cannot be inverted, as is the container shown in Figure 3." The Underhill patent specification also states "If desired, the containers can be stood on end with a valve inverted as shown in Figure 3 which permits the entire contents thereof to be withdrawn without tipping the container or providing any special means of holding the same." Underhill's patent drawings, including Figure 3 which illustrates the container in the upside-down position, show access openings with plenty of room to operate the hand wheel while the container is in use.

27. In considering the Nusbaum application for the patent in suit, the Patent Office examiner did not cite the Underhill patent.

28. Green's Fuel of Florida propane pot of the type shown in the BPN catalogs was in commercial use prior to the date of Nusbaum's alleged invention. The height of the collar on that propane pot was sufficient to permit access to the hand wheel of the valve when the cylinder was inverted. This evidence was not before the Patent Office examiner. The Green's Fuel of Florida propane pot was used only for liquified petroleum gas, had a relief valve setting for liquified petroleum content, and never contained any other material, and specifically never contained a refrigerant. No useful purpose would be served by turning the cylinder upside down and opening

the valve as the escaping combustible liquid would constitute a serious explosion hazard.

29. Nusbaum's first conception of containers of the kind claimed in his patent was in April or May, 1958. He knew at that time that propane pots were on the market for containing propane gas in liquid form under pressure and dispensing it as a gas for fuel purposes. He knew also that Pressed Steel Tank Company made and marketed both propane pots and refrigerant cylinders. He notified an officer of that company that Pennco might want to order several thousand containers of a light, low cost construction, similar to propane pots, that could support themselves in either upright or inverted position to deliver refrigerant in gas or liquid form, and which would have hand access to operate the valve handle in the inverted position.

30. Nusbaum thereafter received from Pressed Steel Tank Company drawings of propane pots that could be adapted for use as refrigerant containers. He also received sample containers. Nusbaum determined that the 3¾ inch high collar, which was standard for Pressed Steel Tank Company's propane pot should be increased 1 inch in height to provide manual access to the valve when the container was inverted. He also specified that the handhold should be larger. Production drawings meeting Nusbaum's specifications were then made. They formed the basis for the drawings Nusbaum submitted in his patent application.

31. Pennco's refrigerant container achieved immediate commercial success.

Conclusions of Law

1. The Court has jurisdiction over the subject matter and the parties.

[1] 2. The presumption of validity of the patent, accorded by 35 U.S.C. § 282, is weakened because of the

failure of Patent Office to cite or consider the 1941 Underhill patent 2,234,458. Triumph Hosiery Mills, Inc. v. Alamance Industries, Inc., 299 F.2d 793 (4th Cir. 1962).

[2] 3. The manner in which Nusbaum made the refrigerant containers does not negative patentability, 35 U.S.C. § 103. It does, however, demonstrate the close relationship between the container and the prior art. Cf. Allen v. Standard Crankshaft & Hydraulic Co., 323 F.2d 29 (4th Cir. 1963).

[3, 4] 4. United States Patent No. 2,956,708 is invalid in its entirety on the following grounds:

(a) The slight modification of a propane pot to adapt it for the dispensing of refrigerants does not constitute invention. An old device is not made patentable by applying it to a new use. General Electric Co. v. Jewel, Incandescent Lamp Co., 326 U.S. 242, 66 S.Ct. 81, 90 L.Ed. 43 (1945); American Monorail Co. v. Parks-Cramer Co., 245 F.2d 739 (4th Cir. 1957).

(b) The difference between Pennco's refrigerant container and the prior art (propane pots) as disclosed by Underhill, United States Patent No. 2,234,458, dated March 11, 1941; Industrie Werke Karlsrube, Belgian Patent No. 514,045, dated September 30, 1962; Pressed Steel Tank Company drawings; Butane-Propane News Catalogs; and the Green's Fuel propane pot "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103; Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162 (1950).

[5] 5. The lack of invention is not doubtful. The commercial success of Pennco's containers, therefore, does not afford a basis for patentability. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147,

71 S.Ct. 127 (1950); American Monorail Co. v. Parks-Cramer Co., 245 F.2d 739 (4th Cir. 1957).

6. The complaint should be dismissed and judgment entered for defendant on the counterclaim.

7. Plaintiff, its officers, agents and those in privity with it, and each of them, should be enjoined and restrained from harassing with threats of infringement against, and from instituting any suit for infringement against, defendant or anyone in privity with defendant, including its suppliers and customers, under United States Patent No. 2,956,708.

8. Defendant should be awarded costs.

Counsel are requested to submit a decree consistent with this memorandum.

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 9539

PENNCO ENGINEERING COMPANY, *Appellant*,

v.

ALLIED CHEMICAL CORPORATION, *Appellee*.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, AT RICHMOND.
JOHN D. BUTZNER, JR., DISTRICT JUDGE.

(Argued November 13, 1964. Decided December 7, 1964.)

Before SOBELOFF, Chief Judge, BRYAN, Circuit Judge, and THOMSEN, District Judge.

* * * * * * * * * *

PER CURIAM:

The District Court has made a thorough analysis of the case. Its findings are well supported and we perceive no error; its conclusions of law are sound. We affirm upon the court's opinion. F. Supp. .

Affirmed.

Judgment

Filed and Entered, December 7, 1964

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 9539

PENNCO ENGINEERING COMPANY, *Appellant,*

v.

ALLIED CHEMICAL CORPORATION, *Appellee.*

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA

This cause came on to be heard on the record from the United States District Court for the Eastern District of Virginia, and was argued by counsel.

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from, in this cause, be, and the same is hereby, affirmed with costs.
December 5, 1964.

SIMON E. SOBELOFF
United States Circuit Judge

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 960

PENNCO ENGINEERING COMPANY,
Petitioner,

v.

ALLIED CHEMICAL CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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April 5, 1965

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

PENNCO ENGINEERING COMPANY, *Petitioner,* v. ALLIED CHEMICAL CORPORATION, *Respondent.*	No. 960

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

There is nothing about this ordinary patent case which warrants a review by this Court on the merits.

The decision of the Court of Appeals for the Fourth Circuit, holding petitioner's refrigerant container patent invalid, is manifestly right. There is no conflict between decisions of Courts of Appeals on the same matter. No question of public importance is involved. There has been no departure from the accepted and usual course of judicial proceedings. In short, there is no special or important reason why the writ prayed for should be granted.

OPINIONS BELOW

The per curiam opinion of the Court of Appeals for the Fourth Circuit is reported at 339 F. 2d 260. The memorandum opinion of the District Court for the Eastern District of Virginia is reported at 235 F. Supp. 625. The District Court's opinion included thirty-one numbered findings of fact and eight numbered conclusions of law.

Both opinions below are printed in petitioner's separate fourteen-page appendix to the petition.

JURISDICTION

The jurisdiction of this Court is invoked by petitioner under 28 U. S. C. § 1254 (1).

QUESTIONS PRESENTED

Questions 1 and 2 of petitioner's "Questions Presented" are framed to create the erroneous impression that the holding of invalidity below was based principally on the District Court's interpretation of one prior art patent, and that the answers to these questions are dispositive with respect to the issue of patent invalidity.

Questions 1 and 2 relate to what was or was not disclosed in only one (Underhill patent 2,234,458) of several prior art references relied on by respondent in support of its defense of patent invalidity for lack of invention over the prior art. Question 1 does not contain even the slightest hint that the conclusion of invalidity was based also on another ground, separate and distinct from lack of patentable invention, or that the single item of prior art which is the subject of petitioner's questions was only one of several prior art references which impelled the Courts below to conclude that the Nusbaum patent did not deserve the accolade of patentable invention.

The conclusions of law entered by the District Court, and characterized as "sound" by the Court of Appeals, make this unmistakably clear. With respect to patent invalidity, the District Court concluded (App. 12*):

> "4. United States Patent No. 2,956,708 is invalid in its entirety on the following grounds:
>
> "(a) The slight modification of a propane pot to adapt it for the dispensing of refrigerants

*The abbreviation "App." is used in this brief to refer to petitioner's fourteen-page "Appendix to Petition for Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit."

does not constitute invention. An old device is not made patentable by applying it to a new use. *General Electric Co.* v. *Jewel*, 326 U. S. 242 (1945); *American Monorail Co.* v. *Parks Cramer Co.*, 245 F. 2d 739 (4th Cir. 1957).

"(b) The difference between Pennco's refrigerant container and the prior art (propane pots) as disclosed by Underhill, United States Patent No. 2,234.458, dated March 11, 1941; Industrie Werke Karlsruhe, Belgian Patent No. 514,045, dated September 30, 1952; Pressed Steel Tank Company drawings; Butane-Propane News Catalogs; and the Green's Fuel propane pot 'are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.' 35 U. S. C. 103; *A & P Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 (1950)"

As we will demonstrate, the Courts below were correct in holding petitioner's patent invalid on either of these grounds.

Petitioner's second question relates to the statutory presumption of validity. This presumption has been frequently brushed aside when Courts have concluded that a patent was improvidently granted by the Patent Office. Furthermore, on the issue of patent invalidity, the Courts below had the benefit not only of the Underhill patent, which was not cited by the Patent Office examiner, but also of other evidence not before the Patent Office.

Petitioner's third question invites this Court to review the legal standards applied by the Courts below in holding the patent in suit "invalid for lack of invention." The legal

standards applied were those of the current statute (35 U. S. C. § 103), and were entirely consonant with the standards expressed and repeatedly applied by this Court in patent infringement cases. These standards were clearly applicable to the facts found below. Any further review by this Court would require a consideration of the findings of fact, and petitioner does not contend that any of these is clearly erroneous.

The only question presented here is whether or not petitioner, defeated in the Courts below, is entitled to another hearing on the merits with respect to the validity of his patent. But, as stated in *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923):

> ". . . The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

STATEMENT OF THE CASE

This is an action for alleged infringement of petitioner's Nusbaum patent 2,956,708, issued October 18, 1960, for "Dispensing Containers for Refrigerants."

The action was tried before the United States District Court for the Eastern District of Virginia in July, 1963. Following extensive briefs and oral argument, the District Court filed its memorandum opinion, findings of fact, conclusions of law, and decree holding the patent invalid.

The Court of Appeals affirmed per curiam, the full text of the opinion reading (App. 14):

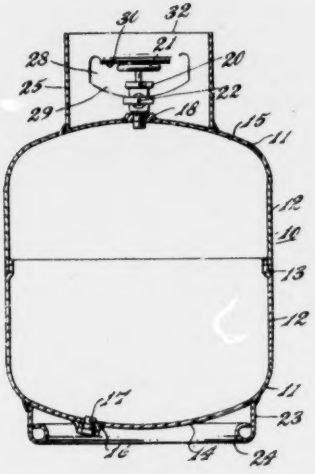
> "The District Court has made a thorough analysis of the case. Its findings are well supported and we perceive no error; its conclusions of law are

sound. We affirm upon the court's opinion, 235 F. Supp. 625."

The Nusbaum patent (FF 5-8;* App. 3-4) shows and describes a container for refrigerants which can be used in the right-side-up or the upside-down position, and relates to details of construction for accomplishing this purpose.

The petition discusses briefly and in general terms the construction of the refrigerant container of the patent in suit. A more detailed description of the container of the patent helps to place Nusbaum's contribution in proper perspective.

Figure 1 of the drawings of the Nusbaum patent (143a)** is reproduced below.



*The abbreviation "FF" refers to the District Court's findings of fact.

**A number followed by the letter "a" identifies the page of appellant's appendix in the Court of Appeals, one copy of which has been filed here by petitioner.

The refrigerant container of the patent is a metal cylinder, closed at both ends. It is provided at the top with a dispensing valve 20 and a protective collar 25 for the valve, and is provided at the bottom with a collar or "foot-ring" 23. The dispensing valve has an outlet 22 for connecting it to a flexible delivery pipe, which is in turn connected to the equipment to be serviced.

The top collar 25, which is of lesser diameter than the container, extends beyond and surrounds the valve, except for an opening at one side. Opposite the opening is a slot or "handhold" 28 for carrying the container. The bottom collar 23 is larger in diameter that the top collar, their relative dimensions permitting the containers to be stacked with the bottom of each upper container resting on the top collar of the container below it.

In the right-side-up position, as shown in Figure 1, the container is supported by the foot-ring or bottom collar. In this position, the refrigerant is dispensed in gas form.

In the upside-down position the container is supported by the top collar 25, which is attached to the top of the cylinder and which partially surrounds and extends beyond the valve. When the container is in this position, the opening in the top collar permits the operator to insert his hand to operate the valve. In the upside-down position, the refrigerant is dispensed in liquid form, at a faster rate than in gas form when the container is right-side-up, thus saving time of the service man.

With respect to the Nusbaum patent, the District Court found (FF 10; App. 5):

> "The principal inventive concept claimed by the plaintiff is the relationship of collar height to valve height which permits manual access to the valve for dispensing liquid refrigerant when the container is inverted, the valve is down and the collar supports

the container. This was achieved by lengthening the collar."

Many of the features of the container shown and described in the Nusbaum patent are old and not a part of Nusbaum's "invention." The District Court found (FF 9; App. 4):

> "The validity of patent is not based upon the following features of the refrigerant container (all of which were known to the industry):
>
> "The use of a container to dispense refrigerant in either liquid or gaseous form;
>
> "The use of a container in the upright or inverted position;
>
> "The metal cylinder or its various sizes;
>
> "The valve;
>
> "The hand wheel for operating the valve;
>
> "The collar on the top of the container which served to protect the valve;
>
> "The handhold in the collar for carrying the container;
>
> "The fuse plug;
>
> "The foot ring for protection of the fuse plug and for stacking."

This extensive catalog of old features makes it apparent that there was little room left for Nusbaum to exercise any ingenuity, and that his limited contribution is not of the calibre on which a seventeen-year patent monopoly should properly be based.

REASONS FOR DENYING THE WRIT

1. The holding of invalidity below is manifestly correct

The Court of Appeals properly characterized the findings of the District Court as "well supported." These find-

ings include a careful and accurate analysis of the disclosure of the Nusbaum patent and its close relationship to the prior art (FF 17-28; App. 7-11). Based on this analysis, the District Court, citing the controlling decisions of its Court of Appeals and of the Supreme Court of the United States, concluded that the Nusbaum claims were invalid because "An old device is not made patentable by applying it to a new use," and also for lack of patentable invention under 35 U. S. C. § 103 (App. 12).

The Court of Appeals approved the "thorough analysis of the case" made by the District Court and affirmed the holding of patent invalidity.

Respondent successfully urged in the Courts below that the Nusbaum refrigerant containers were nothing more than a new use of an old kind of "propane pot." Propane pots are pressure containers for containing and dispensing liquefied petroleum gas. They had been previously manufactured, advertised and sold by Pressed Steel Tank Company and other pressure container manufacturers (316a-319a, 321a, 322a, 325a-327a, 336a), and were exemplified by a prior propane pot demonstrated in open court (93a-94a, 125a). The evidence included various showings of such prior art propane pots which were suitable for, and substantially copied by Nusbaum for, refrigerant containers (31a-47a, 70a).

There was no contention made by respondent that these propane pots were used in the upside-down position, but the evidence and the findings leave no room for doubt that they were used for holding and dispensing liquefied petroleum gas long before Nusbaum's "invention." The District Court quite properly found that "all structural details of the container of the Nusbaum patent were found in prior propane pots," including collars of sufficient height to provide ample hand access to the valves (FF 22, 28; App. 9, 10), and that "the chief difference between refrigerant containers and propane pots is the use to which each is put" (FF 20; App. 8).

The virtual identity between these propane pots and Nusbaum's container was not a result of happenstance. A few weeks before he made his "invention," Nusbaum approached Pressed Steel Tank Company, then known by Nusbaum to be a propane pot manufacturer, in order to arrange for manufacture by Pressed Steel Tank Company of refrigerant containers for Nusbaum (FF 29; App. 11) (31a-32a). The first sample container received by Nusbaum from Pressed Steel Tank Company did not provide ample hand access to the valve when the container was in the upside-down position. This shortcoming was immediately apparent and the "problem" was promptly eliminated by Nusbaum's "contribution": the addition of one inch to the height of the collar (FF 30; App. 11) (36a-39a).

Because of the close similarity, if not identity, between the patented containers and the prior propane pots, the Courts below were fully justified in holding the Nusbaum patent claims invalid, on the settled doctrine that a new use of an old device is not a proper basis for a seventeen-year patent monopoly. This doctrine was clearly enunciated by this Court in *General Electric Co.* v. *Jewel Co.*, 326 U. S. 242, 249 (1945):

> ". . . Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim invention . . . It is not invention to perceive that the product which others had discovered had qualities they failed to detect."

The Courts below were also correct in concluding that the Nusbaum patent was invalid under § 103 of the 1952 Patent Act (35 U. S. C. § 103) on the ground that the refrigerant container of the patent would have been "obvious" to one having ordinary skill in the art, and there-

fore lacked patentable invention. The findings with respect to the prior art relied on in support of this conclusion make it apparent that Nusbaum added only inconsequentially, if at all, to what had preceded him, and that his contribution was indeed obvious, requiring nothing more than commonplace skill.

All of the elements of the Nusbaum container were old, and the prior Underhill patent, not cited by the Patent Office, taught the use of a refrigerant container in either the right-side-up or the upside-down position (FF 26; App. 10). Nusbaum's utilization of old and well-known propane pots which had collars suitable for supporting them in the upside-down position was an obvious use for an obvious purpose, clearly suggested by the prior Underhill patent.

Much of the petition is devoted to a discussion of this prior Underhill patent. Petitioner's comments with respect to what it asserts to be shortcomings in the Underhill disclosure and petitioner's criticisms of the reliance on Underhill by the Courts below are, we believe, unwarranted.

Findings 24 through 27 (App. 9-10) relate to the Underhill patent. The patent shows and describes a container for "Freon," the same refrigerant that is referred to in the Nusbaum patent. The Underhill container is shown in the right-side-up position and the upside-down position, and, when in the latter position, with access through the cage-like support for an operator's hand to reach the valve. The Underhill specification does not expressly refer, in so many words, to the detail of turning the valve on and off to discharge part of the contents in the upside-down position. This concept is nevertheless taught by implication and indeed is inherent in the Underhill disclosure, and the District Court's findings with regard to Underhill are amply supported.

Moreover, the authorities relied on by petitioner in support of its contentions regarding Underhill are not apposite.

Two of these authorities (*Topliff* v. *Topliff*, 145 U. S. 156 (1892), and *Fulton Co.* v. *Bishop & Babcock Co.*, 284 Fed. 774 (6 Cir. 1922)) deal with "anticipation" (invalidity for lack of "novelty" under 35 U. S. C. § 102) by the prior art reference in question, rather than with lack of "patentable invention" (invalidity under § 103 for "obviousness" over the prior art), and the remaining authority (*Permutit Co.* v. *Graver Corp.*, 284 U. S. 52 (1931)) is directed toward an issue which is not presented here, namely, adequacy of disclosure as required by R. S. § 4888, now § 112 of the 1952 Patent Act.

The impact of the prior art deprives Nusbaum of any color of right to assert that he had made a "substantial innovation . . . for which society is truly indebted to the efforts of the patentee," *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 330 (1945).

Apposite here are the remarks of this Court in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 328 (1945):

> ". . . He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge."

Petitioner, like most plaintiffs in patent infringement cases, discusses and relies on the presumption of validity. Much of what petitioner says (Petition, p. 10) concerning what did or did not happen in the Patent Office is based on speculation. But, in any event, the presumption is vitiated in this case because not only the Underhill prior art patent, but also much of the evidence before the Courts

below relating to prior propane pots, was not cited by the Patent Office. This was specifically recognized in the District Court's findings (FF 23, 28; App. 9, 10).

The presumption of validity was discussed in the briefs in the trial court and in the Court of Appeals, and the contentions of the parties regarding it were given full consideration. The settled doctrines regarding the limited role of the presumption of validity were correctly applied by the Courts below.

2. There is no conflict of decisions and no question of public importance is presented

No other suit has been brought on the Nusbaum patent. Thus, there is no decision on the same matter in conflict with the decision of the Court of Appeals for the Fourth Circuit, here sought to be reviewed.

This case is nothing more than a private controversy regarding patent validity. The Nusbaum refrigerant container patent is plainly not a patent of unusual public importance. Applicable here is the rule stated in *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319 (1924):

> ". . . Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of the Circuit Courts of Appeal on the same patent."

The record here does not present any substantial question of Federal law requiring resolution by this Court. This case, relating as it does to the validity of a patent which differs only slightly, if at all, from the prior art is not an appropriate vehicle for interpreting 35 U. S. C. § 103. As demonstrated by the uncontested findings of fact, the Nusbaum patent is invalid, no matter how liberal the standard of invention applied to it.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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